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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,585	02/19/2002	Thomas Knodler	3105.002USU	6312

7590

10/08/2003

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EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,585

Applicant(s)

KNODLER ET AL.

Examiner

Aristotelis M Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/1/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) all is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement filed 3/1/02 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. Although the US patent and DE document 0552564 has been explained, none of the other documents have. Additionally, there are no copies of either German document 4110147 or 9306671.1 associated with the filed IDS, and hence these documents have not been considered as well. The IDS has been reviewed.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations of claims 2-10 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, there is no disclosure to these limitations found in the remainder of the specification to enable one of ordinary skill in the art to make and use the invention.

Claim Objections

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 2,3,4,6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, with respect to claim 2, the claim fails to comply with present USPTO practice with the inclusion of the phrase "for use". Furthermore, it is not clear how the information content further limits the product.

With respect to claims 3,4, and 6 these are interpreted as manufacturing limitations, how the record medium is constructed, not further limiting the product.

With respect to claim 8, this is interpreted as a method of creating the hologram, not the product itself.

AS FAR AS THE CLAIMS RECITE POSITIVE LIMITATIONS THE FOLLOWING REJECTIONS ARE MADE.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claim 1 IS rejected under 35 U.S.C. 102(B) as being ANTICIPATED by Ruell, Babbitt or Behnke.

Ruell, discloses an optical record, (such as a credit card) wherein in order to authenticate the information, additional information is encoded thereon. The key information (for authentication) can be incorporated in a hologram – see col. 1 line 48 to col. 2 line 30. Hence the examiner concludes that the limitations of claim 1 are present and met.

Babbitt discloses an optical record wherein an “encoded” hologram strip is present in order to ensure proper identification. This strip is discloses as being a “key” and necessary in order for the information to be properly decoded.

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Behnke discloses an identification card, wherein additional Key information is encrypted by use of a hologram, see col. 2 lines 62-64.

With respect to claim 2, no patentable weight is given to the phrase "for use" and hence as far as the claim recites positive limitations, such are met by the above noted references. That is, the information conveyed by such is indeed "individualized" information.

14. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0552564 or its US equivalent 5347111 further considered with any of the above noted secondary references to either Ruell, Babbitt or Behnke.

The EP document/US equivalent is relied upon for the reasons stated in the accompanying PCT search report. It lacks the ability of having "encoded" key information included in the hologram.

Ruell, discloses an optical record, (such as a credit card) wherein in order to authenticate the information, additional information is encoded thereon. The key information (for authentication) can be incorporated in a hologram – see col. 1 line 48 to col. 2 line 30. Hence the examiner concludes that the limitations of claim 1 are present and met.

Babbitt discloses an optical record wherein an "encoded" hologram strip is present in order to ensure proper identification. This strip is disclosed as being a "key" and necessary in order for the information to be properly decoded.

Behnke discloses an identification card, wherein additional Key information is encrypted by use of a hologram, see col. 2 lines 62-64.

It would have been obvious to modify the base system of Hoshino (either EP 0552564 or its US equivalent) with the above additional key encoding ability, motivation is to add appropriate encryption key information as needed for either authentication and or provided for a secured record.

15. Claims 3,4,6,8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 as stated in either paragraphs 13 and 14 above, and further in view of Official notice.

With respect to claims 3,4 and 6⁸¹⁰_Λ these are interpreted as manufacturing steps and as such are considered well known in this environment. Hence the use of such well-established techniques for

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the manufacturing of a hologram record is considered obvious to those of ordinary skill in the art, motivation is to use existing techniques to produce the desired product.

With respect to claim 8, this is also considered as established ability of manufacturing a hologram – the use of a mask, which acts as a point source for the hologram and again use of such techniques as established is considered motivation to modify the above systems in order to provide for the record.

16. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 as stated in either paragraph 13 or 14 above, and further in view of Liang et al

The use of fluorescing materials in this environment for holographic records is considered taught by the Liang et al document.

It would have been obvious to modify the base system as noted above in either paragraphs 13 and or 14 with the additional teaching from Liang et al, motivation is to use existing techniques in order to manufacture the product.

17. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 6 above, and further in view of Liang et al.

The use of fluorescing materials in this environment for holographic records is considered taught by the Liang et al document.

It would have been obvious to modify the base system as noted above in with the additional teaching from Liang et al, motivation is to use existing techniques in order to manufacture the product.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The remaining references are cited as illustrative of alternative prior art hologram records in this environment.

Hard copies of the application files are now separated from this examining corps, hence the examiner can answer no questions that requires a review of the file without sufficient lead-time.

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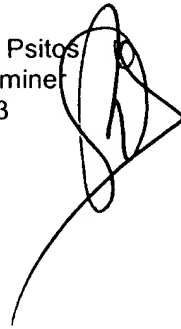
Any inquiries concerning missing papers/references, etc. must be directed to Group 2600 Customer Services at (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Aristotelis M Psitos
Primary Examiner
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A handwritten signature in black ink, appearing to be 'AMP', written over a circular stamp or seal.

AMP